

REMARKS

In this communication, Applicants have amended Claims 3-5, 7-9, 15, 17 and 19; and canceled Claim 11. No new matter is introduced. Claims 1-10 and 12-21 are pending. Allowance of all pending claims is respectfully requested.

In the Office Action of February 23, 2005, the Examiner set forth a number of grounds for objection and rejection. These grounds are addressed individually and in detail below.

Claim Objections

Claims 4-11 and 17-21 are objected to as being in improper form because they are multiple dependent claims depending from other multiple dependent claims. Applicants have amended Claims 3-5, 7-9, 15, 17 and 19 to eliminate the problem. Allowance of the amended Claims is respectfully requested.

Rejection under 35 U.S.C. § 101

Claim 11 is rejected under 35 U.S.C. § 101 because it is directed to non-statutory subject matter as being drawn to a program per se. Claim 11 has been canceled.

Rejections under 35 U.S.C. § 102

Claims 1-3 and 12-16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,023,724 to Bhatia et al. (hereinafter "Bhatia") for reasons stated on pages 3-6 of the Office Action. Applicants respectfully traverse the rejection.

For anticipation under 35 U.S.C. § 102, the reference "must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." (MPEP §706.02). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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Independent Claim 1 is directed to a network modem device configuration system connected to a modem via a local network, the system comprising: a first module sending a request on said local network to said modem to obtain Identification and static IP address data from said modem, a second module receiving a response from said modem and displaying said static IP address, a third module accepting user input to set said static IP address, and a fourth module sending a request on said local network to said modem to set said static IP address. The system provides a mechanism for **initializing a static IP address** for the modem on the LAN via communication with a configuration station on the LAN.

Bhatia generally describes an ISDN LAN modem that automatically adapts itself to a current network environment of a workstation connected to the LAN. The LAN modem detect the IP address of the workstation and then set up its own IP address so that the LAN modem and the workstation are on the same subnet. Bhatia, however, does not describe initializing a static IP address for the modem or the workstation. Specifically, Bhatia does not teach or suggest "a first module sending a request on said local network to said modem to obtain identification and static IP address data from said modem," as well as "a fourth module sending a request on said local network to said modem to set said static IP address."

The Examiner alleges that Bhatia anticipates the first module because Bhatia describes that "workstation inquires address of modem" on col. 24, lines 51-59. Applicants respectfully disagree. The first module of the claimed system functions by sending a request on a local network to a modem to obtain identification and static IP address data from the modem. The cited passage of Bhatia, however, deals with assigning a dynamic IP address to, not obtaining a static IP address from, the workstation. Moreover, the DHCP server 418, which is a component of the LAN modem and the counterpart of the first module, does not send a request on the network to obtain IP address from a modem. The server 418 assigns the E' address to the workstation in response to network IP packets broadcast from the workstation.

The Examiner also alleges that Bhatia anticipates the fourth module of the claimed invention because Bhatia provides that "modem stores IP address" in the

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passage from col. 24, line 44 to col. 25, line 9. Applicants respectfully submit that, as discussed above, the cited section relates to the LAN modem assigning dynamic IP addresses to the workstation and itself, it does not teach or suggest the LAN modem sending a request to the workstation to set a static IP address.

Taken together, Applicants respectfully submit that Bhatia does not anticipate Claim 1 because it does not teach every aspect of the claimed invention either explicitly or impliedly. Withdrawal of the rejection to Claim 1 is respectfully requested.

The Examiner alleges that Bhatia anticipates the fifth module of Claim 2 in the passages on col. 4, line 45 to col. 5, line 10; col. 18, lines 28-36; col. 36, lines 3-6; col. 37, lines 3-18; and col. 48, lines 15-55. Applicants respectfully disagree.

The passage on col. 4, line 45 to col. 5, line 10, as discussed above, deals with assigning dynamic IP addresses. The passage on col. 18, lines 28-36 relates to a mechanism of automatically matching the LAN modem's IP address to that of a host (workstation). The passage on col. 36, lines 3-6, relates to the determination of whether the LAN modem has changed its IP address from a factory setting. The passage on col. 37, lines 3-18 deals with assigning dynamic IP address to a workstation or broadcasting the workstation's IP address through an ARP Request packet. The passage on col. 48, lines 15-55, deals with DNS Induced IP address request procedure in which a remote DNS server sends a DNS reply packet back to a requesting host (workstation) with the IP address of the LAN modem itself as the IP address of the remote DNS server. None of the above-cited passages teach or suggest a module for testing and setting a static IP address for a modem in a network. Accordingly, Applicants respectfully submit that Claim 2 is not anticipated by Bhatia because it depends from Claim 1 and because Bhatia does not teach or suggest the fifth module. Withdrawal of the rejection to Claim 2 is respectfully requested.

The Examiner also alleges that Bhatia anticipates Claim 3 in the passages on col. 36, line 21 to col. 37, line 40; and on col. 24, line 15 to col. 25 line 4. Applicants respectfully disagree. Claim 3 depend from Claim 1 and recites the additional limitation of sending a broadcast discover message by the first module on local network to the modem to solicit a response identifying the modem, receiving and decoding a response

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from the modem by the second module to obtain the identification and static IP address, and broadcasting by the fourth module on the local network to the modem a message including the identification of the modem and an identification of the set static address.

The cited passage on col. 36, line 21 to col. 37, line 40, relates to a workstation broadcasting onto the LAN to provoke a response from a DHCP server. Broadcasting by a workstation is different from broadcasting by the first and fourth modules of the claimed invention because workstation is not a functional equivalent of the modules. The workstation in Bhatia broadcasts to the LAN to obtain a dynamic IP address for itself, while the modules of the claimed invention broadcast to the LAN to obtain and setting a static IP address for another modem.

The cited passage on col. 24, line 15 to col. 25 line 4, relates to the procedure for the LAN modem to set up an IP address for itself. Again, it relates to dynamic addressing but not static addressing.

Accordingly, Applicants respectfully submit that Claim 3 is not anticipated by Bhatia because it depends from Claim 1 and because Bhatia does not teach or suggest modules that broadcast on a LAN, obtain a static address from a modem, and set the static IP address for the modem in the LAN. Withdrawal of the rejection to Claim 3 is respectfully requested.

Independent Claim 12 is directed to a method for initializing a static IP address of a network modem device on a local network, comprising the steps of: broadcasting a request from a configuration station onto said local network; receiving a response to said request at said configuration station from said network modem device comprising an identification for said network modem device, said identification comprising at least an IP address for said network modem device; verifying a compatibility of said identification with settings for said local network; if said identification is compatible with said settings, send a confirmation message with said identification to said network modem device and receive a confirmation response from said network modem device; if said identification is not compatible with said settings, send a new address message comprising a new IP address for said network modem device, receive a change of IP response from said network modem device, send a new address confirmation message

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with said new IP address to said network modem device and receive a new address confirmation response from said network modem device.

As discussed above, Bhatia generally describes an ISDN LAN modem that automatically adapts itself to a current network environment of a workstation connected to the LAN. Bhatia, however, does not teach or suggest Initializing a static IP address of a network modem device. The Examiner alleges that Bhatia anticipates "broadcasting a request from configuration station onto said local network" by the language on col. 24, lines 51-59. Applicants respectfully submit that the relevant passage relates only to workstation using dynamic IP addressing, not static IP addressing. The Examiner also alleges that Bhatia anticipates the step that "if said identification is compatible with said settings, send a confirmation message with said identification to said network modem device and receive a confirmation response from said network modem device" by the language on col. 48, lines 15-55 and col. 18, lines 20-41. Applicants respectfully submit that the relevant passages deal with a DNS induced IP address request procedure (col. 48, lines 15-55) and a mechanism of automatically matching the LAN modem's IP address to that of a host (col. 18, lines 20-41). None of the cited passages specifically teaches or suggests sending a confirmation message with identification to a network modem and receive a confirmation response from the network modem.

Accordingly, Applicants respectfully submit that Bhatia does not anticipate Claim 12 because it does not teach every aspect of the claimed invention either explicitly or impliedly. Applicants further submit that Claims 13-16 are patentable over Bhatia because they depend from Claim 12 and define additional patentable subject matter. Withdrawal of the rejection to Claims 12-16 is respectfully requested.

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In view of the foregoing remarks, favorable reconsideration of all pending claims is requested. Applicants respectfully submit that this application is in condition for allowance and requests that a notice of allowance be issued. Should the Examiner believe that anything further is required to expedite the prosecution of this application or further clarify the issues, the Examiner is requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,
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